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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,176	09/10/2001	Colin T Mallett	36-1483	9581
23117	7590	04/25/2006	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			BATURAY, ALICIA	
			ART UNIT	PAPER NUMBER
			2155	
DATE MAILED: 04/25/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,176

Applicant(s)

MALLETT ET AL.

Examiner

Alicia Baturay

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15, 17-27 and 29-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15, 17-27 and 29-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02152006, 02212006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), which was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 February 2006 has been entered.
2. Claims 13-15, 17-26, 32-34, 36 and 37 were amended.
3. Claims 1-12, 16 and 28 were cancelled.
4. Claims 13-15, 17-27 and 29-37 are pending in this Office Action.

Response to Amendment

5. Applicant's amendments and arguments with respect to claims 13-15, 17-27 and 29-37 filed on 13 February 2006 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

Specification

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

7. Claims 25, 27 and 27 objected to because of the following informalities: they depend on cancelled claims 16 and 28. Appropriate correction is required.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be

commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 6-8, 10-20 and 22-30 of copending Application No. 09/936,325 contain every element of claims 13-15, 17-27 and 29-37 of the instant application and as such anticipate claims 13-15, 17-27 and 29-37 of the instant application. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.
10. “A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F .2nd at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F .3d at 1437, 46 USPQ 2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus. “ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

11. The subject matter claimed in the instant application is fully disclosed in copending Application No. 09/936,325 and is covered by the copending application since the copending application and the instant application are claiming common subject matter, as follows:

The claimed invention in the instant application (claims 13-15, 17-27 and 29-37) is the same as the claimed invention in the copending application (6-8, 10-20 and 22-30) by replacing the name of the limitations such as an ISDN network terminating unit and an ISDN communications link. No new invention or improvement is being claimed in the instant application (claims 13-15, 17-27 and 29-37).

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 13-15, 17-24, 26, 27 and 29-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Ahuja et al. (U.S. 6,222,837).
14. With respect to claim 13, Ahuja teaches an ISDN network terminating unit for receiving digital data via an ISDN communications link naming an ISDN signaling channel and at least one ISDN data channel, the ISDN signaling channel being operable to establish and control

connections between the ISDN network terminating unit and one or more data sources via the ISDN communications link so that data can be transferred from the or each data source to the ISDN network terminating unit via at least one ISDN data channel, the ISDN network terminating unit comprising:

A processor arranged to detect messages transmitted on the ISDN signaling channel that contain at least partial data of a predetermined type (Ahuja, col. 6, lines 48-53), the detected messages comprising sufficient information to enable the ISDN network terminating unit to establish how parts of data of the same predetermined type sent in separate messages are linked to enable the ISDN network terminating unit to reconstitute data (Ahuja, col. 6, lines 21-26): means arranged to extract the at least partial data; and means arranged to store the at least partial data (Ahuja, col. 6, lines 48-53) for passing to a first destination device (Ahuja, col. 6, lines 7-15), the ISDN network terminating unit being arranged to establish how partial data detected in separate ISDN signaling messages are linked and being further arranged to reconstitute the data from the plurality of ISDN signaling messages (Ahuja, col. 6, lines 21-26).

15. With respect to claim 14, Ahuja teaches the invention described in claim 13, including an ISDN network terminating unit where the at least partial data is reconstituted prior to being passed to a first destination device (Ahuja, col. 4, lines 28-32).

16. With respect to claim 15, Ahuja teaches the invention described in claim 13, including an ISDN network terminating unit further comprising means operable to send at least partial

data received for the destination device to further destination devices using messages transmitted on the ISDN signaling channel (Ahuja, col. 6, lines 7-15).

17. With respect to claim 17, Ahuja teaches the invention described in claim 13, including an ISDN network terminating unit in which the at least partial data is a part or a whole at least one e-mail message or other textual message (Ahuja, col. 8, lines 30-34).

18. With respect to claim 18, Ahuja teaches the invention described in claim 13, including an ISDN network terminating unit in which the predetermined type of the at least partial data comprises a software download data type, database search results, news information or telemetry data type (Ahuja, col. 8, lines 50-62).

19. With respect to claim 19, Ahuja teaches the invention described in claim 13, including an ISDN network terminating unit further comprising means operable to detect whether the destination device is active so as to be able to receive the data and, if the device is active, to transmit the data stored by the ISDN network terminating unit to the device (Ahuja, col. 10, lines 27-51).

20. With respect to claim 20, Ahuja teaches the invention described in claim 13, including an ISDN network terminating unit further comprising means operable to receive data from the destination device and to package the data in one or more ISDN signaling messages for transmitting the data to a further destination device (Ahuja, col. 4, lines 28-32).

21. With respect to claim 21, Ahuja teaches the invention described in claim 13, including an ISDN network terminating unit further comprising means operable to detect ISDN signaling messages indicating the set up of a connection to a predetermined destination device and in response to such detection to transmit the data stored by the ISDN network terminating unit to the predetermined destination device (Ahuja, col. 10, lines 27-51).

22. With respect to claim 22, Ahuja teaches the invention described in claim 13, including an ISDN network terminating unit further comprising means operable to monitor the activity of the ISDN signaling channel and to send and/or receive the data of a predetermined type when the ISDN signaling channel activity is within a predetermined range (Ahuja, col. 7, lines 40-50).

23. With respect to claim 23, Ahuja teaches the invention described in claim 13, including an ISDN network terminating unit further comprising:

Means operable to send and/or receive the data of a predetermined type during a predetermined time interval (Ahuja, col. 7, lines 40-50).

24. With respect to claim 24, Ahuja teaches the invention described in claim 13, including an ISDN network terminating unit further comprising:

Means operable to estimate the time for transmitting data to a destination via the ISDN signaling channel and (Ahuja, col. 7, lines 40-50), if the time exceeds a predetermined

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threshold, to transmit the data to the destination using one or more of the ISDN data channels (Ahuja, col. 8, lines 65-67).

25. Claims 26, 27 and 29-36 do not teach or define any new limitations above claims 13, 14 and 17-24 and therefore are rejected for similar reasons.

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 25 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahuja et al. (U.S. 6,222,837) and further in view of Miloslavsky et al. (U.S. 6,625,139).

Ahuja teaches the invention substantially as claimed including packets, which are identified by examining the source, destination, and type information in the packet header are sent over the D-channel (see Ahjua, col. 2, lines 19-23).

28. With respect to claim 25, Ahuja teaches the invention described in claim 16, including an ISDN network terminating unit for receiving digital data via an ISDN communications link naming an ISDN signaling channel and at least one ISDN data channel, the ISDN signaling

channel being operable to establish and control connections between the ISDN network terminating unit and one or more data sources via the ISDN communications link so that data can be transferred from the or each data source to the ISDN network terminating unit via at least one ISDN data channel, the ISDN network terminating unit comprising:

A processor arranged to detect messages transmitted on the ISDN signaling channel that contain at least partial data of a predetermined type (Ahuja, col. 6, lines 48-53), the detected messages comprising sufficient information to enable the ISDN network terminating unit to establish how parts of data of the same predetermined type sent in separate messages are linked to enable the ISDN network terminating unit to reconstitute data (Ahuja, col. 6, lines 21-26); means arranged to extract the at least partial data; and means arranged to store the at least partial data (Ahuja, col. 6, lines 48-53) for passing to a first destination device (Ahuja, col. 6, lines 7-15), the ISDN network terminating unit being arranged to establish how partial data detected in separate ISDN signaling messages are linked and being further arranged to reconstitute the data from the plurality of ISDN signaling messages (Ahuja, col. 6, lines 21-26).

Ahuja does not explicitly teach transmitting a message containing meta data about ensuing messages to be sent to the destination device.

However, Miloslavsky teaches means operable to:

First, establish the number of messages to be transmitted to a destination device and transmit data representing the number (Miloslavsky, col. 39, lines 19-28), second, identify the sender of each message to be transmitted to the destination device and transmit data representing each sender (Miloslavsky, col. 38, lines 6-8), and third, transmit data

representing the text of each message to the destination device (Miloslavsky, col. 38, lines 56-60). If a certain number of messages is reached, the router holds the messages normally transmitted to the server and sends an indication (data representing this number) of this overload to the server so that the server can take appropriate action.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ahuja in view of Miloslavsky in order to enable transmitting a message containing meta data about ensuing messages to be sent to the destination device. One would be motivated to do so in order to parse the content of the messages obtained from the server to extract relevant information.

29. Claim 37 does not teach or define any new limitations above claim 25 and therefore is rejected for similar reasons.

Response to Arguments

30. Applicant's arguments filed 13 February 2006 have been fully considered, but they are not persuasive for the reasons set forth below.
31. The examiner respectfully submits that Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay
April 19, 2006


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER